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OFFICE OF PETITIONS

In re Application :
Athwal et al. :
Application No. 09/875,221 : DECISION ON APPLICATION
Filed: June 6, 2001 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. CARP-0089 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT" filed August 6, 2003. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred twenty-three (223) days to two hundred seventy-three (273) days.

The application for patent term adjustment is **DISMISSED**.

Applicants are given **thirty (30) days** from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

For the reasons set forth herein, the Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days¹. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 6, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 223 days. On August 6, 2003, applicants timely² submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was two hundred seventy-three (273) days. Applicants assert entitlement to a patent term adjustment on the basis that the USPTO failed to mail the first Office action, the Notice of Allowance, within 14 months of the filing date of the application. Applicants dispute

¹ The zero days is determined to be a result of 273 days of administrative delay and 449 days of applicant delay.

² The Issue Fee payment was received in the Office on August 6, 2003.

there being any basis for reduction of the patent term adjustment.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer and that there were no circumstances in the prosecution of the application which constituted failure to engage in reasonable efforts to conclude processing or examination.

The Office initially determined a patent term adjustment of two hundred twenty-three (223) days based on an adjustment for PTO. delay of two hundred seventy-three (273) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) reduced by applicants' delay of fifty (50) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) for failure to timely file a reply to the Notice to File Missing Parts of Application mailed July 18, 2001.

A review of the application file reveals that the applicants' response to the Notice to File Missing Parts of Application mailed July 18, 2001, is of record in the application with a date of receipt by the Office of October 18, 2001. However, this response was not complete. The Notice required applicants to submit a signed oath or declaration and a late surcharge under 37 CFR 1.18(e). In addition, applicants were to provide a substitute computer readable form (CRF) copy of the "Sequence Listing" and a statement. The declaration and late surcharge were accepted as complete and proper replies on October 18, 2001. However, the CRF was found to be unreadable.

The Office mailed a letter requesting a CRF in compliance on September 24, 2002. The CRF filed, in response, on October 24, 2002 was found to be technically good and entered. However, by letter mailed December 9, 2002, the examiner advised applicants that the sequence rule request response was incomplete. On January 9, 2003, applicants filed a response amending the application to correct the error.

Pursuant to 37 CFR 1.704(c)(7), applicants failed to engage in reasonable efforts to conclude prosecution of the application by submitting an incomplete reply to the request to comply with sequence rules set forth in the Notice to File Missing Parts of Application mailed July 18, 2001. 37 C.F.R. § 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In the instant case, an initial reply was filed on October 18, 2001. However, by Notice mailed September 24, 2002, applicants were advised that the reply was not in compliance. On October 24, 2002, applicants filed another response. However, it was determined by the examiner not to be in compliance. Applicants finally submitted a reply correcting the omission on January 9, 2003. Accordingly, the period of adjustment is 449 days, the number of days in the period beginning on October 18, 2001 and ending on January 9, 2003.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is zero (0) days. (273 days reduced by 449 days).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Initial Patent Examination for consideration of the request for corrected filing receipt filed July 28, 2003. Thereafter, the Office will forward the file to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.

Karin Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen